

ESTTA Tracking number: **ESTTA592442**

Filing date: **03/13/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91212665
Party	Plaintiff Ryan Lester
Correspondence Address	CARL I BRUNDIDGE BRUNDIDGE AND STANGER PC 2318 MILL ROAD, SUITE 1020 ALEXANDRIA, VA 22314 UNITED STATES cbrundidge@brundidge-stanger.com
Submission	Opposition/Response to Motion
Filer's Name	Carl I. Brundidge
Filer's e-mail	cbrundidge@brundidge-stanger.com, dmcauley@brundidge-stanger.com,ncolston@brundidge-stanger.com
Signature	/Carl I. Brundidge/
Date	03/13/2014
Attachments	Opposition to Applicants Motion to Suspend filed.pdf(344737 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

RYAN LESTER,

Opposer,

v.

RHAPSODY INTERNATIONAL INC.,

Applicant.

Opposition No. 91212665

Serial No. 85/804,778

Mark: NAPSTER

OPPOSITION TO APPLICANT'S
MOTION TO SUSPEND OPPOSITION
PROCEEDING PENDING OUTCOME
OF CIVIL ACTION

Commissioner of Trademarks
PO Box 1451
Alexandria, VA 22313-1451

I. PRELIMINARY STATEMENT

Opposer/Petitioner, Ryan Lester ("Lester") hereby opposes the motion to suspend filed by Applicant Rhapsody International Inc. ("Rhapsody").

This opposition proceeding seeks to stop the registration of NAPSTER, Application Serial Number 85/804,778, in class 38 for subscription audio broadcasting via electronic communication networks, local and global computer networks and wireless communication networks; audio broadcasting, namely broadcasting music, concerts, and radio programs via electronic communication networks, local and global computer networks and wireless communication networks; streaming and audio content via electronic communication networks, local and global computer networks and wireless communication networks; webcasting services; providing on-line chat rooms and electronic bulletin boards for transmission for messages among

users in the field of general interest. The NAPSTER mark at issue in this opposition proceeding is hereinafter referred to as “the Subject Mark.”

As will be discussed further below, Applicant’s motion to suspend should be denied for the following reason.

Applicant filed an application for the subject mark on or about December 17, 2012 based on their intent to use the subject mark for the above-identified goods/services. The subject mark is not registered at the U.S. Patent and Trademark Office and is not being used.

The Civil Action pending in the United States District Court for the Northern District of California as filed by the Applicant, alleges among other claims, trademark infringement, and is therefore unrelated to this opposition proceeding opposing the intent-to-use application of the subject mark.

II. LEGAL ARGUMENT

THE MOTION SHOULD BE DENIED SINCE THE CIVIL ACTION AND THE OPPOSITION PROCEEDING ARE UNRELATED

On or about April 24, 2013, Applicant counsel sent an initial offer to Lester, the President and CEO of NapsterFM LLC, to purchase the Napster.fm domain. In an attempt to negotiate the purchase and at the request of Applicant’s counsel, Lester sent a counteroffer to Rhapsody on August 21, 2013.

Opposer’s Counsel made several unsuccessful attempts to reach Applicant’s Counsel to continue negotiations regarding the purchase of the Napster.fm domain.

On or about September 19, 2013, Opposer filed U.S. Trademark Application Serial Number 86/069,735 for the mark (“NAPSTER.FM”) having a first use date of March 25, 2012 and a first use in commerce date of November 29, 2012.

On or about September 25, 2013, Opposer filed this opposition proceeding opposing the subject mark based on its resemblance to Opposer’s NAPSTER.FM mark and the goods/services thereof in class 38 as to likely, when used in connection with the services set forth in the application, to cause confusion, or to cause mistake, or to deceive.

On or about December 10, 2013, after the filing of this opposition proceeding and without any response to the counteroffer or any other notice or comment from Applicant's Counsel or Applicant, Opposer received notice from Applicant that it had filed the Civil Action.

The Civil Action alleges trademark infringement on the part of Lester and NapsterFM LLC of Rhapsody's Registered Trademarks including Registration Nos: 3,055,515; 3,054,773; 2,841,431; 2,843,786; 2,843,405; and 3,309,551 and pending Applications including Application Serial Nos: 78/431,602 and 85/804,778.

"Ordinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding may have a bearing on the issues before the Board" (TBMP §510.02(a)).

In this case, the Civil Action is unrelated to registrability of the subject mark and is instead related to trademark infringement. Therefore, this opposition proceeding and the Civil Action are unrelated. *Cf. Zachry Infrastructure LLC v. American Infrastructure Inc.*, 101 U.S.P.Q.2d 1249, 1253 n.6 (TTAB 2011). "The district court may have lacked jurisdiction to entertain a counterclaim to refuse registration because the involved mark was the subject of an application, not a registration." "No claim preclusion based on district court's determination because civil action focused on respective uses and rights to use while Board proceeding focus on right to registration." (Id.)

In this proceeding, as noted above, the subject mark was filed in an intent-to-use application and is therefore not registered before the U.S. Patent and Trademark Office and importantly is not a mark presently being used by the Applicant for the use identified. Therefore, there is no infringement to be decided by the District Court with regards to the subject intent-to-use application. In *Black Box Corp. v. Better Box Communications Ltd*, Opp. 107,800, 2002 WL 484956, at *2 (TTAB 2002), it states "it is the policy of the Board to suspend proceedings when the parties are involved in a civil action which may be dispositive of or have a bearing on the Board case." This case as well as the other cases cited by the Applicant in the motion to suspend, involves trademark registrations and not intent-to-use applications.

This opposition proceeding is concerning an intent-to-use application not a trademark registration, and the Civil Action is concerning trademark infringement, thus these two proceedings are unrelated as the District Court cannot determine infringement of an intent-to-use trademark application which has not been registered before the U.S. Patent and Trademark

Office and importantly is not even being used by the applicant. Further, the Civil Action will not have a bearing on the Board case since infringement could never occur with a mark not being used.

In this case, subject mark is not registered and is not being used by the Applicant. Therefore, the Board should not suspend this opposition proceeding of the subject mark pending the outcome of the Civil Action.

III. CONCLUSION

The motion to suspend should be denied due to this opposition proceeding and the Civil Action being unrelated. Opposer has alleged sufficient reasons why these two matters are unrelated including that the opposition proceeding is related to an intent-to-use trademark application for the subject mark and the Civil Action is related to trademark infringement of a mark allegedly being used.

Respectfully Submitted

Date: March 13, 2014

By: /Carl I. Brundidge/

Carl I. Brundidge
Brundidge and Stanger PC
2318 Mill Road, Suite 1020
Alexandria, VA 22314
Tel: 703-684-1470
Fax: 703-684-1460
Email: cbrundidge@brundidge-stanger.com

CERTIFICATE OF SERVICE

I hereby certify that on this 13th day of March 2014, I caused to be served by electronic mail and first class mail the foregoing Opposition to Applicant's Motion to Suspend the Opposition Proceeding on:

Gia Cincone
Counsel for Applicant
Kilpatrick Townsend & Stockton LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111

Email: gcincone@kilpatricktownsend.com

Respectfully Submitted

Date: March 13, 2014

By: /Carl I. Brundidge/

Carl I. Brundidge
Brundidge and Stanger PC
2318 Mill Road, Suite 1020
Alexandria, VA 22314
Tel: 703-684-1470
Fax: 703-684-1460
Email: cbrundidge@brundidge-stanger.com